

al ("Iwamoto") and further in view of U.S. Patent No. 4,740,963 to Eckley. This rejection is respectfully traversed.

The rejection of claim 1 (and 3) lacks merit for several reasons. First, it would not have been obvious to one of ordinary skill in the art to try and combine Wigren and Iwamoto. Second, it would not have been obvious to one of ordinary skill in the art to try and combine Wigren and Eckley. Third, Iwamoto does not disclose that the reference directory is "stored in a storage means" as recited in claim 1.

A. It Would Not Have Been Obvious To Try and Combine Wigren and Iwamoto

The Office Action asserts Wigren discloses several of the elements of claim 1. The Office Action acknowledges that Wigren fails to disclose that "at least one reference directory is transmitted and is stored in the storage means" as recited in claim 1. However, the Office Action asserts that Iwamoto discloses this feature. The Office Action further asserts it would have been obvious to combine the references.

An Office Action must provide a *prima facie* case for why one of ordinary skill in the art would have thought it obvious to combine the applied references. The Office Action provides no logical reason why one of ordinary skill in the art would have thought it obvious to combine these two references. The Office Action merely asserts that it would be obvious to combine Wigren and Iwamoto because they are from the same field of endeavor. See page 3, line 16 of April 15 Office Action. This assertion is improper for at least two reasons. First, "same field of endeavor," alone, does not establish *prima facie* case of combining the references. Second, Wigren and Iwamoto are not from the same field of endeavor. In particular, Wigren is related to a cell phone communication system, while Iwamoto is related to data mining, as discussed in greater detail below. As such, Applicant respectfully asserts the Examiner has failed to establish a *prima facie* case for combining the applied references.

As discussed during the June 30 interview, Wigren discloses to communicating geographical information in a cell phone system. See [0001] of Wigren. Specifically, Wigren relates to a method of communicating data to cell phones so that they know their geographic position relative to cell towers. In particular Wigren discloses a method of allowing cell phones to determine their altitudes, while minimizing the amount of data which must be communicated over the wireless network at all times. See [0008]-[0010] of Wigren.

By contrast, Iwamoto discloses mining data storage fields to find hidden rules, so that those data fields can be better understood and accessed. See Iwamoto abstract. Iwamoto discloses an apparatus or program which can mine through large amounts of data stored in a data warehouse 24. See col. 8, lines 1-8. This data warehouse is typically a computer hard drive or server. Iwamoto discloses analyzing this data to discover hidden rules or relationships. For example, Iwamoto discloses that its apparatus could be applied to discover the relationships and rules governing the values of cars. See col. 7, lines 61-67 and col. 10, line 53 to col. 11, line 22. The apparatus mines a database filled with information relating to model years, fuel economy, horsepower, etc. The apparatus searches for relationships between the factors to determine what factor might most or least affect the ultimate value of the car.

In view of the above, Wigren and Iwamoto relate to highly disparate fields of endeavor. As such, one of ordinary skill in the art would not have thought it obvious to try and use a feature of a data mining apparatus to fix a problem related to a cell phone location system. The Office Action has failed to identify a specific reason that would have directed one of ordinary skill in the art, using the Wigren reference, to Iwamoto. Therefore, because Wigren and Iwamoto relate to disparate fields of endeavor and because the Office Action provides no further rationale for justifying the combination, Applicant respectfully asserts the Examiner has engaged in impermissible hindsight.

Furthermore, as discussed during the June 30 interview Applicant previously presented this argument in the November 13, 2007 Request for Reconsideration After Final Rejection. However, the Examiner did not respond to this argument, nor provide any additional explanations or rationales to support the Office Action's assertion that Wigren and Iwamoto come from the same field of endeavor. Subsequent Office Actions have simply reiterated the previous assertion that Wigren and Iwamoto come from the same field of endeavor, with no further justification or details. Applicant respectfully requests that the Examiner provide a clear explanation in support of the Office Action's position, in the next Office Action, so that Applicant has a full record for purposes of Appeal.

B. It Would Not Have Been Obvious To Try and Combine Wigren and Eckley

The Office Action acknowledges that Wigren and Iwamoto fail to disclose that "the utilizable data is transmitted in its original format" as recited in claim 1. The Office Action asserts Eckley discloses this feature. However, the Office Action again fails to provide a prima facie case for why one of ordinary skill in the art would have thought it obvious to try and combine Wigren with Eckley.

The Office Action asserts that it would have been obvious to combine Eckley with Wigren "in order for transmitting simultaneously both a voice signal and a digital signal, with reduced distortion to the voice signal and with a higher digital data rate that was previously achieved for a given combined bandwidth." This is the only reason provided to justify combining Wigren and Eckley.

However, as discussed during the June 30 interview, this asserted "reduced distortion" is not disclosed in Wigren. Wigren discloses a method for minimizing the amount of data that needs to be transmitted back and forth from cell towers to the cell phone, while still enabling the cell phone to know its elevation. Wigren does not disclose a desire or intent to

reduce distortion in a voice signal or improve a digital data rate. As such, Wigren does not identify a problem that one of ordinary skill in the art would have gone to Eckley to solve.

Additionally, Wigren and Eckley relate to substantially different fields of endeavor within telephone communications. Eckley discloses a method for transmitting and receiving both voice and digital signals over landline telephones. See col. 1, lines 9-12. By contrast, Wigren relates to communicating geographic information over a wireless cell network. Thus, although both relate to telephone communications they nevertheless relate to substantially different fields of endeavor within telephone communications. For example, a landline (as disclosed in Eckley) does not need to know its altitude or geographic location, which is the primary focus of Wigren. Thus, one of ordinary skill in the art would not have thought it obvious to look for solutions to the problems of Wigren in Eckley.

As such, one of ordinary skill in the art would not have thought it obvious to combine Wigren and Eckley. Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case for combining Wigren and Eckley.

C. Iwamoto Does not Disclose the Recited Storage Means

Finally, even if combined, the cited portion of Iwamoto does not disclose the recited storage means. As discussed during the June 30 interview, the cited portion of Iwamoto fails to disclose a reference directory, or that such a reference directory would be stored in a storage means, as recited in claim 1.

The Office Action asserts that Iwamoto discloses that "at least one reference directory is transmitted and is stored in the storage means" in Figs. 20A-20C and col. 18, line 42 to col. 19, line 16 of Iwamoto. As understood by Applicant, the Office Action is asserting that Fig. 20C discloses that conditional expressions 76 are stored in the data warehouse 24. The Office Action appears to be asserting the conditional expressions are equivalent to the recited reference directory and the data warehouse is analogous to the storage means.

However, the storage means 24 in Iwamoto refer to the storage location of the data to be mined, not a location for storing the conditional expressions. Neither the figures, nor the cited portions of Iwamoto, disclose that the conditional expressions are stored in a storage means.

For at least the above reasons, the rejection of claims 1 and 3 lack merit. Thus, withdrawal of the rejection of claim 1, and claim 3 depending therefrom, is respectfully requested.

II. Claim 21

Claim 21 is rejected under 35 U.S.C. 103(a) over U.S. Patent No. 7,039,421 to Couronne et al. ("Couronne") in view of Iwamoto and Eckley. This rejection is respectfully traversed.

The Office Action asserts that the combination of Couronne, Iwamoto and Eckley discloses all the recited elements of claim 21. However, as discussed during the June 30 interview, Couronne, Iwamoto and Eckley are from disparate technical fields.

Couronne discloses a system for determining the position of an object using a plurality of transmitting and receiving devices. As discussed above, Iwamoto relates to the field of data mining, while Eckley relates to transmitting voice and data information over a landline telephone. These references are in highly disparate fields. Thus, it would not have been obvious to one of ordinary skill in the art, to try and combine the features of these references.

Furthermore, as discussed during the June 30 interview, Applicant previously presented this argument in the November 13, 2007 Request for Reconsideration After Final Rejection. Applicant again respectfully requests that the Examiner provide as detailed an explanation in support of his position, in the next Office Action, as possible so that Applicant has as full a record as possible for purposes of Appeal.

III. Claims 2 and 4-19

Claims 2 and 4-8 are rejected under 35 U.S.C. 103(a) over Wigren, Iwamoto and Eckley, and further in view of U.S. Patent Pub. No. 2006/0135186 to Hans et al. ("Hans"). Claims 9-16 are rejected under 35 U.S.C. 103(a) over Wigren in view of Iwamoto, Eckley, and Couronne. Claims 17-19 are rejected under 35 U.S.C. 103(a) over Wigren in view of Iwamoto, Eckley, Couronne and Hans. These rejections are respectfully traversed.

Claims 2 and 4-19 are all rejected using assorted combinations of Wigren, Iwamoto, Eckley and Couronne. For the reasons articulated above, it would not have been obvious to one of ordinary skill in the art to combine these references.

Additionally, Claims 2 and 4-19 depend from claim 1. Thus, claims 2 and 4-19 also are in condition for allowance based on their dependence from claim 1, as well as for the separately patentable subject matter they recite.

Accordingly, withdrawal of the rejections of claims 2 and 4-19 is respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-19 and 21 is earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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